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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,917	02/20/2004	Tohru Horio	248233US2	5308
22850 7590 01/09/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER MCCULLOUGH, MICHAEL C				
ART UNIT 3653		PAPER NUMBER		
NOTIFICATION DATE 01/09/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdoCKET@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/781,917

Applicant(s)

HORIO, TOHRU

Examiner

MICHAEL C. MCCULLOUGH

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 October 2008 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not support the newly added claim limitations of "at least two detecting devices, **both** located **before** the sheet separating device", "first and second means are located **before** the means for separating", and "the at least two means are located **before** the means for separating". The specification describes sensors 500 and 11 with the separating device/means 9 or 10 between the sensors, See Figures 13A and 15

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4, 6-11, 18-25, and 32-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how one of the detecting devices is located **before** the separating device (as recited in the independent claims) and located **downstream** of the sheet separating device.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-12, 14-26, 28-40, 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobson et al. (US 5,924,686) in view of Sashida (US 6,788,440 B1). Jacobson et al. discloses a sheet pick-up device/means for picking (36) that is a roller, pull-out rollers (46), a drive device/means for driving (47), a detecting device/means for detecting (50), a control device/means for controlling (49) that changes the speed based on a detection result (see column 7 line 54 through column 8 line 22), means for forming an image (12), the control device measures the drive amount (see column 7 line 54 through column 8 line 22) and changes the speed if the detecting device does not detect a leading edge and if the drive amount exceeds a threshold (see column 8 lines 5-22), a display device (see column 9 lines 52-57) that displays information if a threshold is exceeded. Jacobson et al. does not disclose an image reading device/means for reading an image and a sheet separating

device/means for separating comprising a rotary member/means for feeding and a roller/means for obstructing feeding, a second detecting device/second means for detecting. However, Sashida discloses a similar device that includes an image reading device/means for reading an image (400) and a sheet separating device/means for separating comprising a rotary member/means for feeding (221) and a roller/means for obstructing feeding (261), a first and second detecting device/first and second means for detecting (S1 and S2) for the purposes of duplicating an image (see column 7 lines 12-21), separating and conveying an original or only the uppermost one of a plurality of originals (see column 6 lines 22-29), detecting leading edges before separating (see column 8 lines 63-65) and leading edges after separating (see column 9 lines 9-13). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Jacobson et al. by utilizing an image reading device/means for reading an image and a sheet separating device/means for separating comprising a rotary member/means for feeding and a roller/means for obstructing feeding, a second detecting device/second means for detecting, as disclosed by Sashida, for the purposes of duplicating an image, separating and conveying an original or only the uppermost one of a plurality of originals, detecting leading edges before separating and leading edges after separating.

5. Claims 13, 27, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobson et al. (US 5,924,686) in view of Sashida (US 6,788,440 B1), as applied to claims 1-9, 12, 14-23, 26, 28-37, 40, 42-45 above, in farther view of Hamamoto et al. (US 6,421,581 B1). Jacobson et al. in view of Sashida discloses all of

the limitations of the claims but does not disclose a pulse motor. However, Hamamoto et al. discloses a similar device that includes a pulse motor (34) for the purpose of controlling the feeding of a sheet (see column 6 lines 13-35). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Jacobson et al. in view of Sashida by utilizing a pulse motor, as disclosed by Hamamoto et al., for the purpose of controlling the feeding of a sheet.

Response to Arguments

6. Applicant's arguments filed 29 October 2008 have been fully considered but they are not persuasive. Applicant argued that the separating devices 261 and 221 are located between the sensors S1 and S2 of Sashida. In response, the sensors S1 and S2 are located before the most downstream part of rollers 221 and 261 and are therefore considered before the sheet separating device/means.

7. Applicant pointed to support for the new claim limitations in Figure 1, paragraph 0046, and sensors 11 and 400. Figure 1 does not show the claimed sensors, paragraph 0046 does not disclose the claimed sensors, and there is no sensor 400. There are sensors 500, 501, and 11 disclosed in the specification; however, there is only one sensor disclosed before the sheet separating device.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL C. MCCULLOUGH whose telephone number is (571)272-7805. The examiner can normally be reached on Monday-Friday, 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick H. Mackey/
Supervisory Patent Examiner, Art
Unit 3653

MCM